

REMARKS/ARGUMENTS

The Examiner is thanked for the clarity and conciseness of the previous Office Action, and for the citation of references, which have been studied with interest and care.

The following remarks are in response to the Office Action mailed October 22, 2003. In the Office Action, claims 1, 3-12, 14-23, 25-33 stand rejected under 35 U.S.C. § 103. Reconsideration in light of the remarks made herein is respectfully requested. Applicants respectfully traverse the Office Action's 35 U.S.C. § 103 obviousness rejections in their entirety.

Rejection Under 35 U.S.C. § 103

Claims 1, 3-12, 14-23, 25-33 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 6,236,990 Geller et al. (hereinafter Geller) in view of U.S. Patent Application No. 2002/0007322 to Stromberg (hereinafter Stromberg).

A *prima facie* obviousness rejection requires that three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP § 2142; In re Vaeck, 947 F. 2d. 488 (Fed. Cir. 1991).

Further, as aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...

Applicants respectfully submit that independent claims 1, 12 and 23 are not rendered obvious by Geller in view of Stromberg, because even if Geller and Stromberg were combinable, there combination would still not teach or suggest the limitations of independent claims 1, 12, and 23.

Applicants' independent claims 1, 12, and 23 all basically recite: creating a plurality of categories wherein each category identifies an attribute...associating products having at least one attribute with at least one category...and *upon selection of a main product by a user in communication with a visual browser via a computer network, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.*

On the other hand, Geller teaches a very different invention and does not teach or suggest the claim limitations of amended independent claims 1, 12, and 23. As stated in Geller, Geller discloses:

A method and system stores a product catalog, which includes product names and can include a category for each product. Attributes for each product category are identified and products within each category are evaluated by experts who can compare each of the products and how they rate with respect to each attribute. Each of the products in each category is rated for compliance with the attributes identified, for example using a 100-point scale, and the ratings are stored. *The user is prompted to select a category. For the category selected, stored prompts are provided to the user, allowing the user to weigh the importance of each attribute, and this preference information is stored.* The preference and rating information stored is used to rank each product within the category and *provide the ranking to the user*, tailored to the preferences of the user. The user can change a preference and recalculate the rankings based on the new preference information. The user can obtain additional evaluation information, and can order the product. The catalog, attributes, prompts and evaluation information is remotely updatable. (Geller, Column 2, lines 17-37, emphasis added).

As detailed above, in Geller, a user selects a category and for the category selected *stored prompts are provided to the user allowing the user to weigh the importance of each attribute*, and rankings are provided to the user.

As above, because Geller teaches a user selecting a category and providing prompts to the user to allow the user to weigh the importance of each attribute, this actually teaches away (1) from Applicant's invention, which instead is related to *a plurality of categories being automatically created and each category identifying an attribute... products having at least one attribute are associated with at least one category...* and upon selection of a main product by a user in communication with the visual browser via a computer network...automatically displaying a plurality of related products *having at least one attribute in common with the main product that are selectable for purchase by the user.*

Thus, at the outset Geller teaches away from Applicants' invention.

In fact, the Office Action recognizes this, and on page 3 of the Office Action, the Office Action states that Geller does not explicitly teach the limitation that upon selection of a main product by a user in communication with a visual browser via a computer network, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user.

However, the Office Action asserts that Stromberg teaches an electronic product information system that provides product information with a listing of pricing information to consumers over the Internet upon the selection of a main product to be purchased by the user. Based on this, the Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to *display a plurality of related products upon the selection of a main product.*

Applicants respectfully traverse the Office Action's assertions. In contrast, as set forth in paragraph 2 of Stromberg, Stromberg relates to a system for providing supplemental product information to consumers over the Internet...More specifically, the invention of Stromberg relates to a system for providing product-specific, manufactured specifications and other technical information to the consumer upon request in order to supplement online catalog information or information presented in a printed catalog or newspaper advertising supplements. (Emphasis added). (2)

Further, as stated in paragraph 10 of Stromberg, within the pages of a printed catalog and its associated Internet site, selective product items offered by participating resellers are footnoted with a special graphic icon to invite customers to an independent, third-party website to view additional product information deemed useful in making a buying decision...the link or icon contains embedded information for retrieving the specific product information...the web server displays a web page interface identifying the originating catalog and displaying the supplemental information about the product including technical information...once the consumer is finished viewing the information over the internet, the consumer is referred back to the reseller site to complete the sales transaction. (Emphasis added).

Thus, Stromberg teaches that: based upon user selection of a product, product-specific, manufactured specifications and other technical information is provided to the consumer in order to supplement the online catalog. Stromberg has nothing to do with, nor does it teach or suggest, (2) Applicants' limitations of independent claims 1, 12, and 23 directed to: based upon the selection of a main product by a user *automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user*.

Stromberg quite simply does not teach or suggest automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by a user. Stromberg only teaches providing ancillary information for a product selected by the user. Thus, Stromberg clearly does not teach Applicants' claim limitations.

Because Stromberg in combination with Geller does not teach, suggest or render obvious Applicants' independent claims 1, 12, and 23, Applicants respectfully submit that these claims are non-obvious and respectfully request the withdrawal of the obviousness rejection.

In fact, as previously discussed, because Geller teaches a user selecting a category and providing prompts to the user to allow the user to weigh the importance of each attribute, Geller actually teaches away from Applicants' invention. Thus, at the outset Geller should not be combined with Stromberg in the first place. As stated in the MPEP, "it is improper to combine references where the references teach away from the combination." MPEP §2145.

To the extent that the Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to *display a plurality of related products* upon the selection of a main product *that are selectable for purchase by the user*, based on Stromberg, this is insufficient as a matter of law, because as previously discussed Stromberg does not teach or suggest these limitations.

As pointed out by the Federal Circuit, reliance solely on "skill in the art," is generally insufficient to modify a reference to reach an obviousness judgment. In Al-Site Corp. v. VSI Int'l Inc., 50 USPQ2d 1161, 1171 (Fed. Cir. 1999), the Federal Circuit stated: "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." (Emphasis added). As set forth by the Federal Circuit reliance merely on common knowledge and common sense does not fulfill the PTO's obligation to cite references to support an obviousness conclusion, as the PTO must document its reasons on the record to allow accountability and effective appellate review. In re Lee, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to display a plurality of related products upon the selection of a main product for purchase by a user. Applicants respectfully disagree with this assertion. If the Office Action wishes to maintain this rejection, in accordance with MPEP §2144.03, Applicants respectfully request that a reference be cited in support of the Office Actions's position that this teaching existed before Applicant's filing date.

Thus, Applicants respectfully submit that, clearly, the combination of Geller and Stromberg does not teach, suggest, or render obvious Applicants' independent claims 1, 12 and 23 which recite limitations directed to: upon selection of a product by a user, *automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user*.

Based on the foregoing, Applicants respectfully submit that there is no teaching or suggestion in either Geller, Stromberg, alone or in combination, of the claim limitations of Applicants' independent claims 1, 12, and 23. Quite simply, Applicants' claim limitations are not

taught, suggested, or rendered obvious by either of these references. Accordingly, Applicants respectfully request that the Applicants' independent claims 1, 12 and 23 be allowed. Further, Applicants' dependent claims are allowable for being dependent upon allowable base claims.

Conclusion

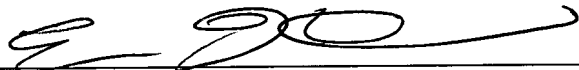
In view of the remarks made above, it is respectfully submitted that pending claims 1, 3-12, 14-23, and 25-33 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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Dated: 12/01/2003

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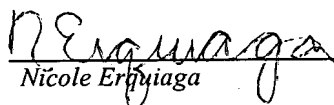
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